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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/505,392

08/20/2004

Peter J Dronzek JR.

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HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/505,392	Applicant(s) DRONZEK ET AL.	
	Examiner Victor S. Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-53 is/are pending in the application.
 4a) Of the above claim(s) 12-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 3/21/2007 have been entered. Claim 1 has been amended. Claims 1-6 and 8-11 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to applicants' argument, the Hoffman reference is withdrawn. Applicants' argument directed to Hoffman is moot.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fischer [US 6328340], and evidenced by Gibbons et al. [US 3702258].

Fischer's invention relates to a form having a detachable card. Fig. 1 shows a form sheet 1 of paper and a piece of a substrate material 2. The substrate 2 further comprises a substrate layer 21, a peeling adhesive layer 22, an outer layer 23, and a permanent pressure-sensitive adhesive layer 24. The substrate 2 is adhered to the lower surface of form 1 by means of the

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permanent pressure-sensitive adhesive layer 24. A piece of a covering material 4, which comprises an outer layer 41 and a permanent pressure-sensitive adhesive layer 42, is provided on the front of the form. The outer layers 23 and 41 are transparent plastic films, such as polyester films [col. 4, lines 46-57]. A punching (die cut) runs all the way through the layers 41, 42, 1, 24, 23 and 22 and reaching down as far as the substrate layer 21 [col. 4, line 62 through col. 5, line 5]. During detaching of the card 3, the peeling adhesive 22 is completely detached from the substrate layer 21 and stays with the card. The peeling adhesive layer 22 has a non-permanent adhesive effect with respect to the substrate 21 and a permanent adhesive effect with respect to the outer layer 23 [col. 5, lines 12-16]. The different adhesive effects with respect to the substrate layer 21 and the outer layer 23 can be achieved by a suitable process control and/or different pretreatment of the surfaces of the layers 21 and 23 [col. 3, lines 28-36]. The detachment from the substrate material 21 has caused layer 22 to lose its stickiness, so that the card 3 is not self-adhesive, and the no longer sticky peeling adhesive layer can be written or printed [col. 5, lines 19-22].

For claims 1, 2, 5 and 8-11, Fischer is silent about 1) the surface treatment pattern, 2) the percentage of treated area. However, regarding item 1), it is known that A.C. produced corona inherently produces a striped pattern across the whole face of the web prior art, as evidenced by the disclosure of prior art reference of Gibbons, which also relates to an improved adhesion to plastic surfaces by corona treatment, and discloses that the amount of corona current has a direct bearing on the adhesion quality [col. 1, lines 26 and 42; col. 2, lines 11-12]. Regarding item 2), since Fischer discloses generally the same subject matter as the instant invention, a workable amount of treated area to achieve the required different adhesive effects is deemed to be either

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anticipated by Fischer, or an obvious routine optimization to one skilled in the art of corona treatment. It should be noted that while Gibbons teaches that additional equipment setup can minimize the inherent stripe pattern for applications in which such a pattern is undesirable, there is no reason whatsoever for Fischer to use a modified equipment, because Fischer is only concerned with adhesion modification.

For claims 3 and 4, Fischer is silent about the thickness of polyester film layer and the weight basis of the paper stock. However, since Fischer teaches the generally same subject matter for the same use (detachable card intermediate) as the instant invention, workable thickness of polyester film and weight basis of paper stock are deemed to be either anticipated by Fischer, or obvious routine optimizations to one skilled in the art of detachable card intermediate, motivated to obtain required card physical properties for use.

For claim 6, Fischer is silent about the amount of difference in adhesion. However, since Fischer teaches the generally same subject matter for the same use as the instant invention, a workable difference in adhesion for achieving different adhesive effects is deemed to be either anticipated by Fischer, or obvious routine optimizations to one skilled in the art of detachable card intermediate, motivated to easily detach the card for use.

Response to Argument

6. Applicants argue at Remarks pages 12-13 that Fischer's peelable adhesive will cause the removed card to stick to other cards. However, Fischer teaches that the detachment from the substrate material 21 has caused layer 22 to lose its stickiness, so that the card 3 is not self-adhesive.

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applicants are reminded that claim 1 and Fig. 1 of instant invention include an adhesive layer 27, which is read upon by the peelable adhesive layer of Fischer. Clearly, applicants' argument is incommensurate with the claimed invention.

Applicants argue that the Fischer patent directs a skilled worker to completely treat the surface of the layer to which the card is adhered. However, as evidenced by Gibbons, A.C. produced corona inherently produces a striped pattern across the whole face of the web prior art, and while Gibbons teaches that additional equipment setup can minimize the inherent stripe pattern for applications in which such a pattern is undesirable, there is no reason whatsoever for Fischer to use a modified equipment, because Fischer is only concerned with adhesion modification.

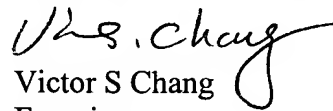
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor S Chang

Examiner

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4/10/2007